REMARKS/ARGUMENTS

I. Amendment to the Specification

Page 6, line 11 of the Specification has been amended to include the U.S. equivalent of originally recited WO99/24080. See Section IV below for further remarks. No new matter is being added by the present amendment to the Specification.

II. Amendment to the Claims

Claim 1 has been amended to correct a typographical error. No new matter is added by the present amendment to the claims.

III. Rejection under 35 USC 112, first paragraph

Claims 1-11 stand rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. Specifically, the Examiner contends that the Specification provides no written description for the hydrogenatable, unsaturated substrate compound recited in the claims. Applicants respectfully disagree.

As set forth in MPEP 2163:

> The written description requirement has several policy objectives. "[T]he 'essential goal' of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed." In re Barker, 559 F.2d 588, 592 n.4, 194 USPQ 470, 473 n.4 (CCPA 1977). Another objective is to put the public in possession of what the applicant claims as the invention. See Regents of the University of California v. Eli Lilly, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). *>"The 'written description' requirement implements the principle that a patent must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the patent is based, and to demonstrate that the patentee was in possession of the invention that is claimed." Capon v. Eshhar, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1084 (Fed. Cir. 2005).

In the present application, Applicants have provided the written description support required for the claimed invention including the "hydrogenatable, unsaturated substrate compound" recited in the claims.

As set forth in the Specification:

> The hydrogenatable substrate used may be a material such as a para-hydrogenation substrate as discussed in WO 99/24080. For *in vitro* or *in vivo* MR studies of biological or quasi-biological processes or synthetic polymer (e.g. peptide, polynucleic acid etc.) syntheses, the substrate is preferably hydrogenatable to form a molecule participating in such reactions, e.g. an amino acid, a nucleic acid, a receptor-binding molecule, etc., either a natural such molecule or an analog. (Specification, page 6, lns. 10-15.)

In the context of the claimed invention, one of skill in the art would understand what is meant by a "hydrogenatable, unsaturated substrate compound" as the terms "hydrogenatable" and "unsaturated" are known terms in the art. In addition, the substrate is further qualified in independent claim 1: "...wherein the substrate compound comprises imaging nuclei;" The term "imaging nuclei" is described on page 5, line 24 through page 6, line 2 of the Specification. Furthermore, the Specification references published document WO99/24080 and its US equivalent 6,574,495 for examples of suitable hydrogenatable, unsaturated substrate compounds. Still further, based on the examples set forth on pages 22-24 of the Specification, one of skill in the art would understand that the hydrogenatable, unsaturated substrate compound will depend upon the desired contrast agent (*e.g.*, if maleic acid is the desired contrast agent, then the hydrogenatable, unsaturated substrate could be acetylenedicarboxylic acid; if succinic acid is the desired contrast agent, then the hydrogenatable, unsaturated substrate could be acetylenedicarboxylic acid or maleic acid).

Based on the remarks above, the Specification as written describes the technology for which protection is being sought and demonstrates possession of the claimed invention. The written description requirement has been met. Applicants respectfully request this rejection be withdrawn.

IV. Objection under 35 USC §132(a)

The amendment to the Specification made on 1/21/2009 is objected to as introducing new matter. Applicants respectfully disagree and believe this objection has been rendered moot by the present amendment. As set forth in MPEP 2163.07, "[m]ere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973)." U.S. Patent No. 6,574,495 is the U.S. equivalent of WO99/24080. Hence no new matter is being added as the amendment is merely an alternative means of describing WO99/24080. Applicants respectfully request this objection be withdrawn.

V. Conclusion

In view of the amendments and remarks hereinabove, Applicants respectfully submit that the instant application, including claims 1-11, is in condition for allowance. Favorable action thereon is respectfully requested.

Any questions with respect to the foregoing may be directed to Applicants' undersigned counsel at the telephone number below.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, in connection with this Response to Deposit Account No. 502-665 in the name of GE Healthcare, Inc.

Respectfully submitted,

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